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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,650	10/15/2001	Per Sjoberg	0459/00346	5908

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,650

Applicant(s)

SJOBERG, PER

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 11, 15 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8, 11 and 14-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant's election of Group I is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, as between Groups I and III, the election has been treated as an election without traverse (MPEP § 818.03(a)). Note that Group III now includes claim 15, in addition to claims 3 and 8.
3. Applicant's election with traverse of Group I is acknowledged. The traversal as to Groups I and II is on the ground(s) that little extra search will be required to examine both groups. This is not found persuasive because this is not believed correct, and since what serves as a common special technical feature must serve to define over the prior art in accordance with PCT Rule 13.2. There is manifestly not a common special technical feature, particularly as no claims define over the prior art. This is further the case as explained and set forth in Papers. No. 13 and 15. Note that Group II now includes 4-7, 11 and 19-21. Although claims 19-21 recite a method, they depend on and further limit claim 4, and thus they are believed properly considered as in Group II.

The requirement is still deemed proper and is therefore made FINAL.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

In these claims, per cent ranges of amounts of guanidine dinitramide are specified, such as “20% to 80% by weight of the gas releasing composition, not including binder.” Applicants have not pointed out the basis therefore, and none is apparent. Applicants are required to point out the original specification basis therefore or to cancel the new matter. The new language, each word *arguendo* having basis, is such that the new concept, or the new expression as a whole, lacks original basis, when fairly viewed in context. Compare *In re Oda*, 170 USPQ 268, and *Ex parte Grasselli*, 231 USPQ 393, as well as MPEP 706.03(o) and 2163-2163.06, where departures (including from cancellations, where each word has basis, but not the expression) from the original disclosure are new matter. Also, as to ranges of ingredients, see *Ex parte Jackson*, 110 USPQ 561. Here, claim 1 recites a pyrotechnic material “comprising guanidine dinitramide and guanyl urea dinitramide as a gas-releasing composition....” Due to the “comprising” scope, additional ingredients and in any amounts are permitted. However, applicants have provided no basis for the new range in claims 16-18, which only applies to one of the ingredients. There is no specification basis for such. This is particularly the case in view of the “not including” limitation. No basis is set forth for this.

Whatever may be in the specification, such is insufficient for the range as to amounts and ingredients as newly specified in claims 16-18.

6. Claims 1-2, 14 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 are indefinite. As best understood, claim 1 recites making a device by providing a composition. There is no method step in this recitation that relates to any device limitations. While

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the “providing” [a pyrotechnic material] limitation newly added to claim 1 is an improvement over original claim 1, it in an of itself fails to prepare a safety device. One can provide a pile or pellet of composition by placing it upon a workbench. Such does not change the workbench into a car safety device. Thus, the preamble is inconsistent with the body of the claim. Further, the language used is so indefinite that what is actually required by the claims, e.g., the metes and bounds, cannot reasonably be determined. The language may inherently have implied limitations no otherwise recited. Such are improper and contribute to the inability to define the metes and bounds of the claimed invention. These exemplary problems render the claims indefinite, as it cannot be determined what type of claim is being claimed, e.g., what the claimed invention is.

In claim 2, line 2, the term “amount to adjust the rate” is used, without any manner of, or parameters for, determining the amount. Assuming *arguendo* that the two different substances recited in claim 1 have different burning rates, the claims 2 limitation is not a further limitation, but would be inherently always the case, as written. Should the burning rates be identical, then the claims 2 limitation would never be true. In any event, claim 2 as amended remains indefinite, and appears improper as failing to further limit the subject matter of claim 1, 35 USC 112, 4th paragraph.

In claim 14, “the gas-releasing substance” lacks antecedent basis in claim 1. Further, it is not clear how any form, tablet or otherwise, relates to the method step of providing in claim 1.

Claims 1-2 are incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are that the claims are a method of making a device, but there are no device limitations or device related method steps recited. The newly added method step of “providing” a material or a composition does not comprise any method

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step effective to make any safety device. There is no recitation of any parts or apparatus content of the apparatus, nor any assembly or other step to effectively prepare any device or apparatus.

In claim 16-18, the recitation of “not including binder” is indefinite, as claim 1 from which these claims depend has no antecedent basis for binder. Perhaps some kind of binder or rivets or welding material or glue is implied for assembling the device. This cannot be known, as none such is recited. How then is the device held together without any means to hold the presumably assembled device together? It is further indefinite as to how such relates to the composition if such was intended, as there is no such composition limitation recited either. In fact, since no such limitation is contemplated in claim 1, and the specification contemplates use of no binder, then this is apparently a useless term. The claims should recite what they include, not as excluding what is absent from being, of is not recited in any event. Further, if this relates to the amounts, the amounts cannot be reasonably determined at all, when only 20-80%, e.g., of one ingredient and excluding a binder is recited. These amounts are so indefinite that it is not possible to determine what applicant might have intended, whereby there might be additional problems of lack of understanding.

The claims, although improved, remain generally narrative and indefinite, and still fail to conform with current U.S. practice. They still appear to be a literal translation into English from a foreign document and remain replete with errors. The above are exemplary; the claims should be completely revised to be in accord with US practice. They certainly fail to reasonably set forth the metes and bounds of the claimed invention.

7. Claims 1-2, 14 and 16-18 are rejected under 35 U.S.C. 103(a) as obvious over Blomquist, 6,004,410, in view of Langlet, WO 98/55428.

Blomquist '410 teaches airbag devices containing [provided with] GDN (guanidine dinitramide), for example, at col. 2, line 32. In instant claims 1-2, a “suitable” amount of guanyl urea

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dinitramide might be 0% to obtain the examiner's required burning rate. Likewise, "possible" amounts of binder include 0%, especially in claims 16-18, and more than 50% of GDN includes 100%. Thus, possibly no claim but claims 16-18 requires any additional ingredient beyond GDN. This is problematic due to the indefinite nature of the claims. To the extent appropriate, Blomquist '410 may be the epitome of obviousness, anticipation, as broadly construed. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The claim 14 "tablet" form is taught at col. 4, lines 63-67. In any event, it would have been clearly obvious to combine a plurality of ingredients to prepare a gas generating composition, where the properties of use in such are well known and the combination produces the expected result, a safety device of some utility. Thus, the device produced is an unspecified safety device having a propellant or gas generating material. There is nothing unobvious about preparing such devices, including by providing the propellant therefore. Langlet, WO 98/55428, teaches the similar use of guanylurea dinitramide for the same purpose as the GDN of Bloomquist '410. Thus, combining the ingredients or the compositions to obtain the desired average of properties would have been obvious. Where the ingredients are well known and combined for their known properties, the combination is obvious, absent unexpected results, *In re Crockett*, 126 USPQ 186, *In re Pinten*, 173 USPQ 801, and *In re Sussman*, 43 CD 518. Further, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423.

To the extent appropriate, variation of specific amounts (as in claims 16-18) and well known ingredients would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
December 31, 2003


EDWARD A. MILLER
PRIMARY EXAMINER